

FORM PTO-1390  
(REV 10-95)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE ATTORNEY'S DOCKET NUMBER

**TRANSMITTAL LETTER TO THE UNITED STATES  
DESIGNATED/ELECTED OFFICE (DO/EO/US)  
CONCERNING A FILING UNDER 35 U.S.C. §371**

SCH 1742

U.S. APPLICATION NO. (If known, see 37 CFR §1.5)

**09 / 4 8 5 2 9 2**

INTERNATIONAL APPLICATION NO.

INTERNATIONAL FILING DATE

PCT/EP98/05064

10 August 1998

PRIORITY DATE CLAIMED

09 August 1997 (earliest)

TITLE OF INVENTION

**NEW EPOTHILONE DERIVATIVES, PROCESS FOR THEIR PRODUCTION, AND THEIR PHARMACEUTICAL USE**

APPLICANT(S) FOR DO/EO/US

Ulrich KLAR, et al.

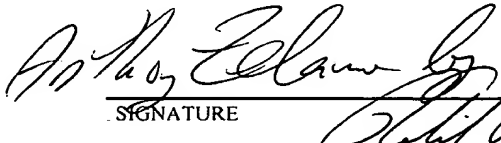
**Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:**

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. §371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. §371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. §371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. §371(b) and PCT Articles 22 and 39(1).
4. ☒ A proper Demand for International Preliminary Examination was made by the 19<sup>th</sup> month from the earliest claimed priority date.
5. ☒ A copy of the International Application as filed (35 U.S.C. §371(c)(2))
  - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☒ has been transmitted by the International Bureau.
  - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☒ A translation of the International Application into English (35 U.S.C. §371(c)(2)).
7. ☒ A copy of the International Search Report (PCT/ISA/210).
8. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. §371(c)(3))
  - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b. ☐ have been transmitted by the International Bureau.
  - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
  - d. ☒ have not been made and will not be made.
9. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. §371(c)(3)).
10. ☐ An oath or declaration of the inventor(s) (35 U.S.C. §371(c)(4)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. §371(c)(5)).

**Items 13. to 19. below concern document(s) or information included:**

13. ☐ An Information Disclosure Statement under 37 C.F.R. §§1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 C.F.R. §§3.28 and 3.31 is included.
15. ☒ A FIRST preliminary amendment.
  - ☐ A SECOND or SUBSEQUENT preliminary amendment.
16. ☐ A substitute specification.
17. ☐ A change of power of attorney and/or address letter.
18. ☐ Certificate of Mailing by Express Mail
19. ☒ Other items or information:

Letter  
PCT/IB/304  
PCT/IB/308  
PCT/IB/332

|   |              |   |   |   |  |
|---|--------------|---|---|---|--|
| U.S. APPLICATION NO. (if known, see 37 CFR § 1.53) <b>09/4852</b>   |              | INTERNATIONAL APPLICATION NO. <b>PCT/EP98/05064</b> |   | ATTORNEY'S DOCKET NUMBER<br><b>SCH 1742</b> |  |
| 17. <input checked="" type="checkbox"/> The following fees are submitted:<br><b>BASIC NATIONAL FEE ( 37 CFR §1.492 (a) (1) - (5)):</b><br>Search Report has been prepared by the EPO or JPO..... \$840.00<br>International preliminary examination fee paid to USPTO (37 CFR §1.482)..... \$670.00<br>No international preliminary examination fee paid to USPTO (37 CFR §1.482) but international search fee paid to USPTO (37 CFR §1.445(a)(2))..... \$760.00<br>Neither international preliminary examination fee (37 CFR §1.482) nor international search fee (37 CFR §1.445(a)(2)) paid to USPTO..... \$970.00<br>International preliminary examination fee paid to USPTO (37 CFR §1.482) and all claims satisfied provisions of PCT Article 33(2)-(4)..... \$96.00<br><b>ENTER APPROPRIATE BASIC FEE AMOUNT =</b> |              |   |   | <b>CALCULATIONS</b> -- PTO USE ONLY         |  |
|   |              |   |   |   |  |
| Surcharge of <b>\$130.00</b> for furnishing the oath or declaration later than months from the earliest claimed priority date (37 C.F.R. §1.492(e)). <input type="checkbox"/> 20 <input checked="" type="checkbox"/> 30   |              |   |   | \$840.00                                    |  |
|   |              |   |   | \$130.00                                    |  |
| CLAIMS  | NUMBER FILED | NUMBER EXTRA  | RATE  |   |  |
| Total claims  | 30 - 20 =    | 10  | x \$ 18.00  | \$180.00                                    |  |
| Independent claims  | 8 - 3 =      | 5   | x \$ 78.00  | \$390.00                                    |  |
| MULTIPLE DEPENDENT CLAIM(S) (if applicable)   |              |   | + \$ 260.00   |   |  |
| <b>TOTAL OF ABOVE CALCULATIONS =</b>  |              |   |   | \$1,540.00                                  |  |
| Reduction of 1/2 for filing by small entity, if applicable. A Verified Small Entity Statement must also be filed (Note 37 C.F.R. §§1.9, 1.27, 1.28).  |              |   |   |   |  |
| <b>SUBTOTAL =</b>   |              |   |   | \$1,540.00                                  |  |
| Processing fee of <b>\$130.00</b> for furnishing the English translation later than months from the earliest claimed priority date (37 C.F.R. §1.492(f)). <input type="checkbox"/> 20 <input type="checkbox"/> 30   |              |   |   |   |  |
| <b>TOTAL NATIONAL FEE =</b>   |              |   |   | \$1,540.00                                  |  |
| Fee for recording the enclosed assignment (37 C.F.R. §1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 C.F.R. §§3.28, 3.31). \$40.00 per property.  |              |   |   |   |  |
| <b>TOTAL FEES ENCLOSED =</b>  |              |   |   | \$1,540.00                                  |  |
|   |              |   |   | Amount to be refunded:                      |  |
|   |              |   |   | charged:                                    |  |
| a. <input checked="" type="checkbox"/> A check in the amount of <u>\$1,540.00</u> to cover the above fees is enclosed.<br>b. <input type="checkbox"/> Please charge my Deposit Account No. <u>13-3402</u> in the amount of \$_____ to cover the above fees. A duplicate copy of this sheet is enclosed.<br>c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. <u>13-3402</u> . A duplicate copy of this sheet is enclosed.  |              |   |   |   |  |
| <b>NOTE: Where an appropriate time limit under 37 C.F.R. §§1.494 or 1.495 has not been met, a petition to revive (37 C.F.R. §1.137(a) or (b)) must be filed and granted to restore the application to pending status.</b>   |              |   |   |   |  |
| SEND ALL CORRESPONDENCE TO:<br>MILLEN, WHITE, ZELANO & BRANIGAN, P.C.<br>Arlington Courthouse Plaza I<br>2200 Clarendon Boulevard, Suite 1400<br>Arlington, Virginia 22201<br>(703) 243-6333  |              |   |   |   |  |
| Filed: 8 February 2000<br><br>AJZ:jvbp  |              |   | <br>SIGNATURE |   |  |
|   |              |   | Anthony J. Zelano<br>NAME   |   |  |
|   |              |   | <u>27,969</u><br>REGISTRATION NUMBER  |   |  |

420 Rec'd PCT/PTO 0 8 FEB 2000

## IN THE UNITED STATES DESIGNATED/ELECTED OFFICE

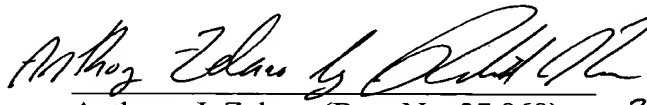
INTERNATIONAL APPLICATION NO. : PCT/EP98/05064  
INTERNATIONAL FILING DATE : 10 August 1998  
PRIORITY DATE CLAIMED : 09 August 1997 (earliest)  
Applicant(s) (DO/EO/US) : Ulrich KLAR, et al.

Title: NEW EPOTHILONE DERIVATIVES, METHOD FOR PRODUCING SAME AND  
THEIR PHARMACEUTICAL USE

## LETTER

If the claims of the above-identified International Application were amended under Articles 19 and/or 34 of the PCT, it is requested that examination in the U.S. National Phase be based on the claims as originally filed under the PCT and any attached Preliminary Amendment is based on the original claims.

Respectfully submitted,

  
Anthony J. Zelano (Reg. No. 27,969) 30515  
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Blvd., Suite 1400  
Arlington, VA 22201  
Direct Dial: 703-812-5311  
Fax No: 703-243-6410  
Internet Address: zelano@mwzb.com

Filed: 08 February 2000